

REMARKS

STATUS OF THE CLAIMS.

Claims 1-24 are currently pending in the application and are subject to the current Restriction Requirement.

ELECTION/RESTRICTION.

Claim Groups

In the present Office Action ten Claim Groups were identified and restriction, under 35 U.S.C. §§ 121 & 372, to one of the Claim Groups for prosecution in the present application was required. The ten Claim Groups identified are as follows:

- I. Claim 1, drawn to a method of detecting a disease related prostatic acid phosphatase conformer using conformer specific antibodies.
- II. Claim 2, drawn to a method of identifying an inhibitor of a disease related prostatic acid phosphatase conformer.
- III. Claims 3 and 18-21, drawn to methods of making or identifying antibodies specific to prostatic acid phosphatase conformers.
- IV. Claims 4-6, drawn to a method of establishing a profile of a disease related prostatic acid phosphatase conformer.
- V. Claim 7, drawn to method of selecting treatment using a prostatic acid phosphatase conformer profile of Group IV.
- VI. Claims 8-11, drawn to a monoclonal antibody specific to prostatic acid phosphatase conformer.
- VII. Claims 12-14, drawn to methods for detecting prostate cancer.
- VIII. Claims 15 and 22, drawn to prostatic acid phosphatase conformers.
- IX. Claims 16-17, drawn to methods of making prostatic acid phosphatase conformers.
- X. Claims 23-24, drawn to methods for treating prostate disease using the conformers of Groups VIII and IX.

Discussion

The current claims are subject to a restriction requirement that divides the claims into ten different Groups as provided above. The restriction requirement also alleged that the claims do not share a technical feature that is a contribution over the prior art.

Applicants elect Group 1 and respectfully traverse.

Applicants suggest the following six Groups as an alternative restriction:

- I. Claims 1-3, drawn to detection methods relying on specific binding of prostatic acid phosphatase conformers to antibodies or inhibitors.
- II. Claims 4-7, drawn to methods of establishing and using disease related prostatic acid phosphatase conformer profiles.
- III. Claims 8-11, drawn to a monoclonal antibody specific to a prostatic acid phosphatase conformer.
- IV. Claims 12-14 and 23-24, drawn to methods of detecting and treating prostate disease using prostatic acid phosphatase conformers and antibodies thereto.
- V. Claims 15 and 22, drawn to prostatic acid phosphatase conformers.
- VI. Claims 16-21, drawn to methods of making prostatic acid phosphatase conformers and antibodies thereto.

As provided in M.P.E.P § 803, "If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent and distinct inventions." The above suggested restriction provides six groups, each of which can be searched and examined without serious burden.

For example, suggested Group I is drawn to detection methods relying on the specific binding of prostatic acid phosphatase (pACP) conformers, e.g., to antibodies or inhibitors. The number of claims in this group is small and the inventive concept of specific binding to pACP conformers can be used to search all claims in the group without serious burden.

Suggested Group II claims likewise share an inventive concept of pACP conformer profiles. A search of disease related profiles involving pACP conformers would be sufficient to examine both groups and can be done without serious burden.

Suggested Group III is the same as Examiner's Group VI.

Suggested Group IV claims all involve prostate disease and the use of pACP conformers in detection or treatment.

Suggested Group V is the same as Examiner's Group VIII.

The claims of Suggested Group VI all rely on a specific method of making a pacp conformer and antibodies thereto. A search of these claims would be coextensive and can be done without undue burden.

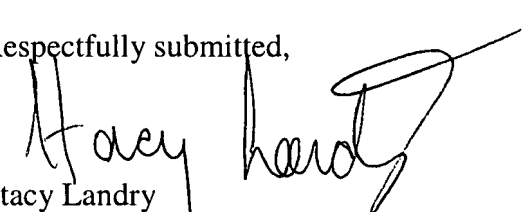
Applicants hereby elect Claim Group 1 with traverse. Accordingly, examination of claims 1-3 and rejoinder of groups as described above is respectfully requested.

Applicants would also like to thank the Examiner for the helpful citation to Lee in relation to the restriction requirement and note that the claims all contain a technical feature that is novel over Lee, e.g., binding to a specific pacp conformer, and that Lee does not anticipate the claimed invention. Applicants would be happy to address the issue in detail if and when an actual rejection is made over the art.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3505.

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Respectfully submitted,


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